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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/760,864	01/16/2001	Mika Partain	2271/63926	4206
7590	10/25/2004		EXAMINER	
Ivan S. Kavrukov Cooper & Dunham LLP 1185 Avenue of the Americas New York, NY 10036			GART, MATTHEW S	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 10/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	<i>S</i>
	09/760,864	PARTAIN ET AL.	
	Examiner	Art Unit	
	Matthew S Gart	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 04 October 2004.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-21 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date _____

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____

DETAILED ACTION

Claims 1-20 are pending in the instant office action. Claims 1, 6, 15 and 20 are in independent form.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Rubin et al. U.S. Patent No. 6,078,897.

Referring to claim 1. Rubin et al. discloses a method of promoting product sales in Internet transactions (at least Abstract) comprising:

- Delivering display information to a customer side for ordering products by entering order information at the customer side for transmission to a seller side via the Internet (at least column 3, lines 59-65);
- In response to an initial order entered at the customer side for a specified product and a specified quantity thereof that is in a first selected range, delivering order processing information to the customer side for said initial order (at least column 3, line 59 to column 4, line 31);

- Delivering to the customer side display information indicative of at least a first promotion functionally related to the initial order, only if the specified quantity of the specified product is within a second range that is higher than a minimum quantity and the first range, wherein no promotion is displayed at the customer side if the specified quantity does not meet or exceed the minimum quantity; and
- In response to an entry of a first revised order at the customer side conforming to the first promotion, delivering to the customer side order processing information for said first revised order (at least Abstract).

The Examiner notes, the phrases “only if the specified quantity of the specified product is within a second range...” and “if the specified quantity does not meet or exceed the minimum quantity...” does not move to distinguish the claimed invention from the reference (Rubin et al.). These phrases are both conditional limitations. The noted “if” step is not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Referring to claim 2. Rubin et al. further discloses a method including responding to an initial order entered at the customer side for a specified product and quantity thereof that is in a third range higher than the second range by delivering to the customer side display information indicative of at least a second promotion that is different from the first promotion and is functionally related to the initial order that is in said second range; and in response to an entry of a second revised order at the

customer side conforming to the second promotion, delivering to the customer side order processing information for said third revised order (at least Fig. 3).

Referring to claim 3. Rubin et al. further discloses a method in which said first promotion is for a retail sales transaction and said second promotion is for a business-to-business transaction (at least column 1, lines 26-53, "As used herein, the term "product" is intended to mean any goods or service.").

Referring to claim 4. Rubin et al. further discloses a method in which said information indicative of a first promotion includes information regarding a difference between the initial order quantity and a quantity for qualifying for the first promotion (at least Abstract).

Referring to claim 5. Rubin et al. further discloses a method in which said customer side and seller side are at geographically remote locations (at least column 1, line 26 to column 2, line 20).

Referring to claim 6. Rubin et al. discloses a method of carrying out a sales transaction over a network such as the Internet from a customer side (at least Abstract) comprising:

- Displaying a first screen at the customer side in response to which the customer enters information including an initial product order (at least Fig. 3);
- Displaying a second screen at the customer side that selectively includes information regarding at least one promotion functionally related to the initial product order, and offering the customer choices including confirming the initial product order and changing to a revised product order related to said at least one

promotion, only if the initial product order meets or exceeds a minimum quantity, where no promotion is displayed at the customer side if the initial product order does not meet or exceed the minimum quantity (at least Fig. 3); and

- Displaying a third screen at the customer side containing information regarding status of the sales transaction following a response by the customer to said choices (at least column 9, lines 13-17).

The Examiner notes, the phrases "only if the initial product order meets or exceeds a minimum quantity..." and "if the initial product order does not meet or exceed the minimum quantity" does not move to distinguish the claimed invention from the reference (Rubin et al.). These phrases are both conditional limitations. The noted "if" step is not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Referring to claim 7. Rubin et al. further discloses a method in which the second screen includes the information regarding the at least one promotion when the initial product order meets or exceeds a selected minimum (at least column 8, lines 20-67).

Referring to claim 8. Rubin et al. further discloses a method in which the second screen includes the information regarding the at least one promotion only when the initial product order is within a selected range (at least column 8, lines 20-67).

Referring to claim 9. Rubin et al. further discloses a method in which the selected range is in terms of quantity of items of the same product included in said initial product order (at least column 8, lines 20-67).

Referring to claim 10. Rubin et al. further discloses a method including displaying at the customer side information regarding a difference between the initial product order and an order that would qualify for the at least one promotion (at least column 8, lines 43-47).

Referring to claim 11. Rubin et al. further discloses a method in which the second screen includes information regarding a first selected promotion when the initial product order is within a selected first range but a second selected promotion when the initial product order is in a second range (at least Fig. 3).

Referring to claim 12. Rubin et al. further discloses a method in which the second range is higher than the first (at least column 8, lines 43-47).

Referring to claim 13. Rubin et al. further discloses a method including displaying at the customer side information for a business-to-business sales transaction when the initial product order is in the second range (at least column 8, lines 43-47).

Referring to claim 14. Rubin et al. further discloses a method including displaying at the customer side order processing information for a retail sale when the initial product order or the revised product order is in a first range but for a business-to-business sale when the initial product order or the revised product order is in a second, higher range (at least column 7, lines 48-64).

Referring to claim 15. Rubin et al. discloses a method of carrying out a sales transaction over a network (at least Abstract) comprising:

- Displaying an ordering screen at a customer side containing information regarding at least one product and entering an initial product order including information identifying a product and quantity being ordered (at least Fig. 3);
- Displaying a promotion screen at the customer side containing information regarding at least one selected promotion when the initial product order has a selected characteristic, wherein no promotion is displayed at the customer side if the initial product order does not have the selected characteristic (at least Fig. 3);
- Providing for the entry of a revised product order at the customer side following a display of said at least one selected promotion (at least Fig. 3); and
- Completing the sales transaction in accordance with said revised product order when such is entered but in accordance with the initial product order when the at least one selected promotion was not displayed because the initial product order did not have the selected characteristic or when no revised product order was entered, but processing the sales transaction in accordance with the revised product order when such was entered (at least Fig. 3).

The Examiner notes, the phrase "if the initial product order does not have the selected characteristic" does not move to distinguish the claimed invention from the reference (Rubin et al.). The phrase is a conditional limitation. The noted "if" step is not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied – regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Referring to claim 16. Rubin et al. further discloses a method in which said characteristic includes a quantity of products included in said initial product order (at least Abstract).

Referring to claim 17. Rubin et al. further discloses a method including displaying at the customer side a promotion screen for a retail sales transaction when said selected characteristic is indicative of a retail order but a promotion screen for a business-to-business sales transaction when the selected characteristic is indicative of a business order (at least column 1, lines 44-54).

Referring to claim 18. Rubin et al. further discloses a method in which the selected characteristic is at least one a quantity of a product and a total price of said initial product order (at least Abstract).

Referring to claim 19. Rubin et al. further discloses a method in which said promotion screen is for retail transaction when at least one of a quantity of products and total price of said initial product order is within a first range but is for a business-to-business transaction when at least of a quantity of product and a total price of said initial product order is in a second, higher range (at least column 1, lines 44-54).

Referring to claim 20. Rubin et al. further discloses a system for promoting product sales in Internet transactions (at least Abstract) comprising:

- A customer side computer facility and a seller side computer facility each coupled with the Internet and sending information to the other only over the Internet (at least column 7, lines 22-47);

- Said customer side facility having a display for information received from the seller side facility and an information entry device for entering information sent to the seller side facility through the Internet (at least column 7, lines 22-47);
- Said customer side facility sending to the seller side facility information indicative of an initial order for a product and, depending at least on the quantity of the product, the seller side facility responding by executing the order or sending to the customer side facility information describing at least one promotion functionally related at least to said quantity, only if said quantity meets or exceeds a minimum quantity, wherein no promotion is displayed at the customer side if the quantity of the initial order does not meet or exceed the minimum quantity (at least Fig. 3);
- Said customer side facility selectively responding to said information regarding said promotion by sending to the seller side facility information indicative of a revised order conforming to said promotion (at least Fig. 3); and
- Said seller side facility responding to a revised order from the customer side facility by executing the revised order rather than the initial order (at least Fig. 3).

The Examiner notes, the phrases "only if the said quantity meets or exceeds a minimum quantity..." and "if the quantity of the initial order does not meet or exceed the minimum quantity..." does not move to distinguish the claimed invention from the reference (Rubin et al.). These phrases are both conditional limitations. The noted "if" step is not necessarily performed. Accordingly, once the positively recited steps are

satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Referring to claim 21 (new). Claim 21 is rejected under the same rationale as set forth above in claims 1-20.

Response to Arguments

Applicant's arguments filed 10/4/2004 have been fully considered but they are not persuasive.

The Examiner notes, claims 1, 6, 15 and 20 have been amended to clarify the claimed invention. All of these claims were amended to recite "where no promotion is displayed at the customer side if the initial product order does not meet or exceed the minimum quantity."

The Examiner notes, this newly amended phrase does not move to distinguish the claimed invention from the reference (Rubin et al.). The phrase is a conditional limitation. The noted "if" step is not necessarily performed. Accordingly, once the positively recited steps are satisfied, the method as a whole is satisfied -- regardless of whether or not other steps are conditionally invocable under certain other hypothetical scenarios.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3625

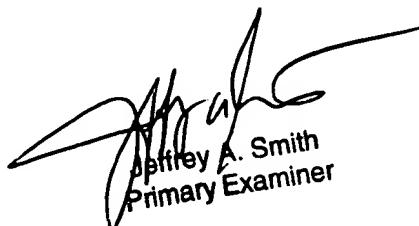
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Matthew Gart whose telephone number is 703-305-5355. This examiner can normally be reached Monday-Friday, 8:30AM-5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ms. Wynn Coggins can be reached on 703-308-1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

MSG
Patent Examiner
October 20, 2004



Jeffrey A. Smith
Primary Examiner